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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,939	04/16/2001	Mark Vange	CIRC022	5609
25235	7590	01/30/2006	EXAMINER	
HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,939

Applicant(s)

VANGE ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,10,11 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,10,11 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-7, 10, 11, and 18-26 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 November 2005 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-7, 10, 11, and 18-26 have been considered but are moot in view of the new ground(s) of rejection.

Request for Information under 37 CFR 1.105

An issue of knowledge by others or public use or on sale activity has been raised in this application. In order for the Examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(a) and (b), additional information regarding this issue is required as follows.

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Any information regarding the "VR-1 Conductor" product noted by evidence cited by the Examiner in this Office Action, this product being attributable to the assignee and any of its former and/or current parent and/or subsidiary companies, including VR-1, Inc., is requested by the Examiner under 37 CFR 1.105 is being pertinent to the issue of patentability in this case. In view of the disclosures of the documents listed, the documents raise an issue as to whether the claimed invention, the features of which are broadly disclosed in the documents, was known and/or used by the public or subject to an offer for sale to the public and the Examiner has deemed any information concerning these products attributable to the assignee to be reasonably pertinent to the issue of patentability.

All individuals covered by 37 CFR 1.56 (reproduced in MPEP 2001.01) have a duty to disclose to the U.S. Patent and Trademark Office all material information they are aware of regardless of the source of or how they become aware of the information. See MPEP 2001.06 and *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 267 F.3d 1370, 1383, 60 USPQ2d 1482, 1490 (Fed. Cir. 2001) ("Once an attorney, or an applicant has notice that information exists that appears material and questionable, that person cannot ignore that notice in an effort to avoid his or her duty to disclose."). Materiality controls whether

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information must be disclosed to the Office, not the circumstances under which or the source from which the information is obtained. If material, the information must be disclosed to the Office. The duty to disclose material information extends to information such individuals are aware of prior to or at the time of filing the application or become aware of during the prosecution thereof.

The Examiner notes that within the evidence filed with this Office Action, namely "VR-1, Inc. to Release an Updated Version of its Vr-1 Conductor Networking Technology at the Tokyo Game Show" ("Conductor"), that one of the named inventors, Mark Vange, specifically mentions one of the above named products, therefore, the inventor is reminded of his duty to disclose information as requested above. This disclosure by the inventor, along with the rest of the evidence cited, provide the basis for the Examiner's request for information under 37 CFR 1.105.

The Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment. See 37 CFR 1.105(c). It is also noted that the requirement for information extends from individuals identified under 37 CFR 1.56(c) or any assignee to the instant application. See 37 CFR 1.105(a) and 37 CFR 1.56(c) ("Individuals associated with the filing or prosecution of a patent application within

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the meaning of this section are: (1) Each inventor named in the application; (2) Each attorney or agent who prepares or prosecutes the application; and (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.")

In response to this requirement, please provide any examples concerning the above referenced products.

The Examiner is authorized to require the submission of this information since the Examiner has determined that such information is relevant to the patentability of the claimed invention. See *Star Fruits S.N.C. v. United States* (Fed. Cir. 2005) ("So long as there is some legitimate reason for seeking the information under section 1.105, the applicant has a duty to respond...The Office is authorized under section 1.105 to require any information that is either relevant to patentability under any nonfrivolous legal theory, or is reasonably calculated to lead to such relevant information"). The above cited references are cited as the reason for making this requirement for information.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR

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1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item. See 37 CFR 1.105(a)(3).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10, 11, and 18-26 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

One policy of the "on sale" and "public use" bars is the prevention of inventors from exploiting their inventions commercially more than 1 year prior to the filing of a patent application. Therefore, if applicant's precritical date activity is a sale or offer for sale that is an attempt at market penetration, a patent is barred. Thus, even if there is bona fide experimental activity, an inventor may not commercially exploit an invention more than 1 year prior to the filing date

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of an application. *In re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979). The extent of commercial activity which constitutes 35 U.S.C. 102(b) "on sale" status depends upon the circumstances of the activity, the basic indicator being the subjective intent of the inventor as manifested through objective evidence, wherein one of the factors indicative of commercial exploitation is the demonstration of models or prototypes of invention, especially at trade conventions even though no orders are actually obtained.

In view of the evidence cited by the Examiner, specifically the press release "Hasbro Interactive to License VR-1's Online Gaming Technologies" ("Hasbro"), the Examiner submits that the Applicant commercially exploited their invention more than 1 year prior to the filing of a patent application, the filing date of the instant application being 17 April 2000 based on the filing of provisional application 60/197490.

Specifically within "Hasbro", the press release discloses that "Furthering the proliferation of its online content technologies worldwide, VR-1®, Inc. announced today (Examiner's note: 21 January 1999) that Hasbro Interactive, Inc. has licensed the Vr-1 Conductor™ server technology and software development kit (SDK) for use in its upcoming line-up of 11 Em@il games." and "The agreement is VR-1's first publicly

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announced licensing deal with a major software publisher to develop games for the VR-1 Conductor platform". The Examiner submits that this constitutes a sale of the invention and that a patent is barred under the on sale criteria under 35 USC 102(b).

The Examiner further submits evidence, namely "Conductor", which shows that the product that was sold corresponds to the specification of the instant application.

"Conductor" discloses:

"VR-1 Conductor helps mitigate the effects of latency in online gaming by optimizing packets; setting bandwidth limits; accommodating varying modem speeds; and monitoring client and server CPU and network performance. It also facilitates network administrative functions such as game management, security and billing. In addition to its sophisticated client/server, communications and management applications, VR-1 Conductor version 1.1 now provides the following new features:

-- Relational database support for building persistent worlds, sharing data across multiple servers, saving game data (scores, player rankings, etc.), and providing real-time game data to lobbies and other game-launching facilities; (Examiner's note: this appears to correspond to the "distributed database" and/or "global cookie database" disclosed within the specification)

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-- A more efficient communication protocol that supports hundreds to thousands of users depending on the type of game being played; (Examiner's note: This appears to correspond to the "TMP" protocol disclosed throughout the specification)

-- More aggressive bandwidth (sp) management for smoother network performance;

-- Improved player synchronization, which is essential for multiplayer gaming."

In view of the evidence cited by the Examiner, specifically "Hasbro" and "The Computer Game Developers Conference (CGDC) - Show - Expo" ("Expo"), the Examiner also submits that the Applicant further commercially exploited their invention more than 1 year prior to the filing of a patent application by demonstrating a model or prototype of the invention at a trade convention, namely the Computer Game Developer's Conference in May 1998. As the "Expo" document shows on page 7, the Applicant attended the Computer Game Developer's Conference which discloses that "VR-1 will be demonstrating its VR-1 Conductor™ technology suite...VR-1 Conductor solves the problems game developers face when designing games for the Internet such as packet loss, latency, and game administration. VR-1 Conductor also assists network operators in the monitoring and maintenance of online game hosting."

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"Hasbro" discloses that "VR-1 Conductor first became available to developers at the Computer Game Developer's Conference in May 1998, and has been endorsed by many leading network providers around the world for its performance, reliability and easy integration into existing networks." This disclosure further proves that the Applicant attended the Computer Game Developer's Conference to commercially exploit their invention more than 1 year prior to the filing of a patent application and possibly offered the invention for sale to others than those listed within "Hasbro" based on the specific knowledge of others of the invention more than 1 year before the filing of the instant application.

Claims 1-7, 10, 11, and 18-26 are rejected under 35 U.S.C. 102(a) since the invention was known by others in this country before the invention thereof by the applicant for a patent.

In view of the cited evidence, namely "Hasbro" and "Expo", the Examiner submits that the invention was known by others in this country before the invention thereof by the applicant for a patent. "Hasbro" discloses that "VR-1 Conductor first became available to developers at the Computer Game Developer's Conference in May 1998, and has been endorsed by many leading network providers around the world for its performance,

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reliability and easy integration into existing networks." "Expo" also discloses that the Computer Game Developer's Conference occurred in May 1998 in Long Beach, California. These disclosures prove that the invention was known by others in this country before the invention thereof by the applicant for a patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn



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